

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT F. WILKINS, DAVID B. BEFFA-NEGRINI
and DAVID M. HALL

Appeal No. 1998-2847
Application No. 08/521,873¹

ON BRIEF

Before STAAB, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42. Claims 3 to 11, 13, 17 to 26, 28, 30 to 37, 39 and 43 to 61 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

¹ Application for patent filed August 31, 1995.

Appeal No. 1998-2847
Application No. 08/521,873

We REVERSE and enter a new rejection pursuant to 37 CFR
§ 1.196(b).

BACKGROUND

The appellants' invention relates to an add-on board game. A copy of the claims under appeal appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Wilson	4,585,233	Apr. 29,
1986		

Claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wilson.²

² On page 6 of the brief (Paper No. 18, filed October 6,
(continued...))

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 8, mailed February 3, 1997) and the examiner's answer (Paper No. 21, mailed May 7, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

²(...continued)
1997), the appellants state that the appeal with respect to claims 1 and 27 is withdrawn with respect to the 35 U.S.C. § 102(b) rejection.

We will not sustain the rejection of claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under 35 U.S.C. § 112, second paragraph.

The examiner determined (final rejection, p. 2) that the claims under appeal were indefinite because the preamble of claims 1 and 27 positively recites only the add-on board but the body of claims 1 and 27 also positively recites "the existing game board." In addition, the examiner determined (final rejection, p. 2) that the phrase "substantially similar to the game board described in Figure 1 of the U.S. Pat. No. 2,026,082" recited in claim 27 was vague and indefinite since "[a]pplicant is not permitted to reference his own drawing [sic, a drawing in an issued patent] to define the invention in a claim."

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In this case, we agree with the reasoning set forth in the appellants' brief (pp. 7-10) that the examiner's bases for this rejection are inappropriate. In that regard, we note that the examiner did not respond to the appellants' argument. Moreover, it is clear to us that (1) "the existing game board" is not positively recited in the claims on appeal, and (2) there is no per se rule that an applicant is not permitted to reference a drawing figure.

For the reasons stated above, the decision of the examiner to reject claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under 35 U.S.C. § 112, second paragraph, is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 and 27 are directed to a combination of an add-on board and three elements expressed in means-plus-function format (i.e., means for indicating, entry transition means, and exit transition means).

Claims drafted in means-plus-function format are subject to the definiteness requirement of 35 U.S.C. § 112, second paragraph:

[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

In re Donaldson, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc); see also In re Dossel, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1884-85 (Fed. Cir. 1997).

After review of the appellants' disclosure, it is our opinion that such disclosure fails to adequately disclose what structure corresponds to the three elements expressed in means-plus-function format (i.e., means for indicating, entry transition means, and exit transition means). While the specification (page 26, line 20, to page 29, line 10) provides some support for these three elements, it is our view that the specification does not specifically disclose the structure that corresponds to each of the claimed "means." What structure corresponds to the entry transition means for randomly causing a player to enter onto the add-on board? What structure corresponds to the exit transition means for randomly causing a player to exit the add-on board? In addition, after reviewing the appellants' original disclosure, it appears to us that the appellants have misused the phrase "randomly causing" since when playing the game the player "may" choose to transition to or from the add-on board based on the roll the dice (see page 26, line 20, to page 27, line 20 of the specification). Thus, using the example set forth on page 27, lines 5-8, while the total roll of the device being odd or even is random, when a player rolls an even

number that would pass a transition location, the player can choose to either remain on the present game board or transition to the other game board. We do not see how presenting such a choice to a player is "randomly causing" a player to enter onto or exit the add-on board. Lastly, it is not clear what structure corresponds to the means for indicating since such structure may be the structure which corresponds to the entry transition means, and/or the exit transition means. Thus independent claims 1 and 27 and their dependent claims fail to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

In addition, it is our view that the phrase "substantially similar" as used in claim 27 fails to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. The term "substantially" is a term of degree. When a word of degree is used, such as the term "substantially" in claim 27, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company,

Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826,
221 USPQ 568, 573-74 (Fed. Cir. 1984).³

In the present case, the appellants' disclosure does not provide explicit guidelines defining the meaning of "substantially similar." Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the term "substantially" as used in the terminology "substantially similar" that would enable one skilled in the art to ascertain what is meant by "substantially." Absent such guidelines, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

³ In Seattle Box, the court set forth the following requirements for terms of degree:

When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

Appeal No. 1998-2847
Application No. 08/521,873

Page 11

The anticipation rejection

We will not sustain the rejection of claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under 35 U.S.C. § 102(b).

We emphasize again here that claims under appeal contain unclear language which renders the subject matter thereof indefinite for the reasons stated supra as part of our new rejection under 35 U.S.C. § 112, second paragraph. We find that it is not possible to apply the prior art to the claims under appeal in deciding the question of anticipation under 35 U.S.C. § 102(b) without resorting to speculation and conjecture as to the meaning of claims 1 and 27. This being the case, we are therefore constrained to reverse the examiner's rejection of claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under 35 U.S.C. § 102(b) in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). This reversal of the examiner's rejection is based only on the procedural ground relating to the indefiniteness

of these claims and therefore is not a reversal based on the merits of the rejection.⁴

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under 35 U.S.C.

§ 112, second paragraph, is reversed, the decision of the examiner to reject claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under 35 U.S.C. § 102(b) is reversed, and a new rejection of claims 1, 2, 12, 14 to 16, 27, 29, 38 and 40 to 42 under

35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203

⁴ The examiner did not set forth the structure of Wilson which he considered to correspond to each of the three recited means-plus-function elements.

Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 1998-2847
Application No. 08/521,873

Page 16

MATTHEW B. LOWRIE
WOLF, GREENFIELD AND SACKS, P.C.
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

APPEAL NO. 1998-2847 - JUDGE NASE
APPLICATION NO. 08/521,873

APJ NASE

APJ CRAWFORD

APJ STAAB

DECISION: **REVERSED;**
37 CFR § 1.196(b)

Prepared By: Gloria Henderson

DRAFT TYPED: 29 Apr 99

FINAL TYPED: